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EXAMINER	
JARRETT, SCOTT L	
ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,204	ROZELL ET AL.	
	Examiner	Art Unit	
	SCOTT L. JARRETT	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *26-40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed July 28, 2008. Currently Claims 1-40 are pending with claims 26-40 being withdrawn as being directed to a non-elected invention.

Election/Restrictions

2. Applicant's election with traverse of evaluating travel accommodations in the reply filed on July 28, 2008 is acknowledged. The traversal is on the ground(s) that there is no undue search burden. This is not found persuasive because invention I (Claims 1-25) and invention II and (Claims 26-40) are combinations disclosed as usable together. The subcombinations are distinct from each other if they are shown separately usable. Invention I is a system/method for assigning a hotel marketability index to one or more hotel properties. Invention II is a system/method for sending marketing communications (e.g. coupons) to a user based on information stored in user profile (neither feature recited in Invention I). Invention I has separately utilizing such as assigning hotel marketability index scores, without the need for user profile information or sending marketing communications.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claims 5, 13, 20, 22 and 25 are objected to because of the following informalities. Appropriate correction is required.

Regarding Claim 5, claim 5 recites if based instead of is based as intended. Appropriate correction required.

Regarding Claim 22, claim 22 recites weightone instead of the intended weight one. Appropriate correction required.

Regarding Claims 12, 20 and 25, claims 12, 20 and 25 recite mormalized instead of the intended normalized. Appropriate correction required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1- 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, 4, 6, 7, 8, 9, 12, 15, 18, 21, the phrase "may be" or "may use" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

For the purposes of examination examiner assumes the applicant will amend the claim to recite that apparatus, method and/or system actually intends to claim the limitations following the phrases "may be" or "may use". Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding 9-14, Claims 9-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 9-14 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at

1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Regarding Claims 1-12, 14-18, 20- 23 and 25, The claims, as currently recited, appear to be directed to a compilation of data without any tangible result and are therefore deemed to be non-statutory while the compilation of data may have some real world value (i.e. utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any "acts" which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diamond v. Diehr, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations

preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (Abele, 684 F.2d 902, 907, 214 USPQ 682, 687(CCPA 1982)). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2dat 1452 and State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In Warmerdam the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claims 1-12, 14-18, 20- 23 and 25 merely recite a method/system for evaluating travel accommodations wherein a plurality of data is collected and/or generated (i.e. useful and concrete). While the invention may be concrete and/or useful, there does not appear to be any tangible result.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-6, 8-9, 11, 13, 15, 17, 19-20 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwoh, U.S. Patent Publication No. 2001/0034625.

Regarding Claims 1, 9 15 and 25 Kwoh teach a system and method for evaluating travel accommodations comprising:

- identifying a plurality of hotel properties (Paragraph 0037, Figure 5);

- assigning a hotel marketability index (score, rating, ranking, metric, value, etc.) to one or more of the hotels, the score/index based on *at least one of the following* (selected one or more) characteristics: rate competitiveness, availability, location within a cluster (country, state, zip, city, group, set, etc.) or quality with a cluster (country, state, zip, city, group, set, class, category, etc.; Paragraphs 0037, 0046 ;Figures 5, 10); and

- ranking (sorting, prioritizing, etc.) the hotels (assuming applicant corrects 'may be' phrase in pending claims; Paragraphs 0037, 0046, 0049; Figures 5, 6, 10)

Regarding Claims 3, 11, 17 and 23 Kwoh teaches a system and method further comprising collecting external data associated with one or more hotel properties, the external data being used to assign the hotel index/score (Paragraphs 0037; Figure 5).

Regarding Claim 5 Kwho teaches a system and method wherein hotel quality is based on a star quality system by one or more reviewing entities (Paragraphs 0037, 0046; Figure 5).

Regarding Claims 6, 13, 19 and 24 Kwoh teaches a system and method wherein the hotel index/score is provided/displayed on one or more web pages wherein an end user uses the hotel index/score in conjunction with navigating the site (assuming applicant's correct the phrase may be; Paragraphs 0002, 0028, 0030; Figure 2, Element 235).

Regarding Claims 8, 4 and 20 Kwoh teaches a system and method wherein data associated with the characteristics is normalized (assuming applicant's correct the phrase may be; Paragraph 0049).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 2, 10, 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh, U.S. Patent Publication No. 2001/0034625 as applied to claims 1, 9, 15 and 25 above, and further in view of Dutta et al., U.S. Patent No. 7,124,096.

Regarding Claims 2, 10, 16 and 22 Kwoh teaches a system and method wherein one or more of the hotel property characteristics is selected (assuming applicant corrects may be phrase; Paragraphs 0037, 0046) and weighting one or more hotel characteristics (Paragraph 0049).

While the weighting and/or prioritizing one or more selection criteria for evaluating travel accommodations is well known Kwoh does not expressly teach that one or more of the hotel property characteristics is selected and *weighted* more than one of the other characteristics such that the *hotel index/score* is affected as claimed.

Dutta et al. teach that one or more of the hotel property characteristics is selected and weighted more than one of the other characteristics such that the hotel

index/score is affected (priority values; Column 6, Lines 37-44; Column 8, Lines 64-68; Column 9, Lines 1-15) in an analogous art of evaluating travel accommodations for the purpose of assisting users find the best-fit/most suitable travel accommodations based upon weighted one or more hotel property characteristics (Column 9, Lines 1-15).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for evaluating travel accommodations as taught by Kwoh would have benefited from weighting (prioritizing) one or more of the hotel property characteristics in view of the teachings of Dutta et al. the resultant system/method enabling users to rank/sort a plurality of hotel properties based on a prioritized/weighted set of one or more hotel property characteristics (Dutta et al.: Column 9, Lines 1-15).

12. Claims 4, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh, U.S. Patent Publication No. 2001/0034625 as applied to claims 1, 9, 15 and 25 above, and further in view of Carro, U.S. Patent No. 7,007228.

Regarding Claims 4, 12, and 18 Kwoh teaches a system and method wherein the cluster location is based on geographic information including the location of the hotel property (Paragraphs 0036, 0048, 0051).

Kwoh does not expressly teach wherein the cluster location is based on geographic longitude and latitude coordinates as claimed.

Carro teaches wherein the cluster location is based on geographic longitude and latitude coordinates (i.e. the old and very well known utilization of geo-coding address, use of Geographic Information System; Column 3, Lines 15-45; Column 5, 35-57; Column 7, Lines 15-18; Column 8, Lines 47-50; Figure 1) in an analogous art of evaluating travel accommodations (e.g. finding travel accommodations in a certain cluster/geographic region) for the purpose of enabling users to find/locate one or more services (e.g. hotels) in a geographic area/region (cluster) without the need to know exact street names, addresses or the like; Column 3, Lines 25-29; Column 5, Lines 36-57).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for evaluating travel accommodations as taught by Kwoh would have benefited from utilizing geographic coordinates (longitude/latitude) in view of the teachings of Carro; the resultant system/method enabling users to identify travel accommodations within a cluster without the need or limitation of specific address information (Carro: Column 3, Lines 25-29; Column 5, Lines 36-57).

Neither Kowh nor Carro expressly teach that the location is modified to account for densely populated areas associated with a selected cluster location however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific location of the one or more hotel properties. Further, the structural elements remain the same regardless of the specific location of the one or more hotel properties. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.*

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh, U.S. Patent Publication No. 2001/0034625 as applied to claims 1, 9, 15 and 25 above, and further in view of Young et al, U.S. Patent Publication No. 2004/00098287.

Regarding Claim 7 while the modifying of data contained on websites by system administrators' is old and very well known Kwoh does not expressly teach that a system administrator modifying the hotel index/score (assuming applicant's correct the phrase may be) as claimed.

Young et al. teach a system and method for evaluating travel accommodations further comprising a system administrator modifying the hotel index/score (Paragraph 0030) in an analogous art of evaluation travel accommodations for the purpose of enabling system administrators override hotel property scores/index which does not reflect the system administrators understanding/desired score/index (override; Paragraph 0030).

Young et al. further teach a system and method for evaluating travel accommodations comprising: collecting a plurality of hotel property characteristics (price, availability, location, cluster, etc.), generating a marketability index for each of the one or more hotel properties, ranking the hotel properties based on one or more weighted hotel property characteristics (rating analysis, weighting analysis (Paragraphs 0009, 0014, 0030-0032, 0040) and displaying the hotel index/score.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for evaluating travel accommodations as taught by Kwoh would have benefited from enabling one or more users (e.g. system administrators) to modify the hotel property score/index in view of the teachings of Young et al.; the resultant system/method enabling system administrators to override an existing hotel property index/score (Young et al.: Paragraph 0030).

Further it is noted that who 'actually' modifies the hotel index/score/rating merely represents non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of who edits/modifies data related to the hotel properties. Further, the structural elements remain the same regardless of who edits/modifies data related to the hotel properties. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.*

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schneider et al., U.S. Patent 5,832,452, teach a system and method for evaluating travel accommodations comprising: a hotel database, user reviews, one or more hotel property characteristics (location, price availability, cluster location, etc.) and assigning a hotel marketability index (service class, rating, etc.) to one or more hotel properties.

- Heissenbuttel et al., U.S. Patent NO. 6,993,503, teach a system and method for evaluating travel accommodations comprising: assigning a hotel marketability index (e.g. star rating) to one or more hotel properties, ranking one or more hotels properties within a cluster.

- Jaehn et al., U.S. Patent Publication No. 2003/0125994, teach a system and method for evaluation travel accommodations comprising: assigning a hotel marketability index score to one or more hotel properties (e.g. star rating) within a cluster (distance ranges).

- Booking a Hotel Room Online is i-Deal with TravelWeb.com (2003), teaches an online system and method for evaluating travel accommodations comprising displaying hotels based on customer criteria such as rate, location, availability, and proximity.

- Kimes, How Product Quality Drives Profitability (2001), teaches a method for evaluating travel accommodations comprising generating and assigning a hotel

marketability index to a plurality of hotel properties comprising: normalizing hotel characteristics, comparing hotels within a cluster, and quality assurance ratings.

- The world's best hotels (2001), teaches a method for rating and ranking a plurality of hotel properties in one or more clusters comprising assigning a hotel marketability index score to each hotel property based on a plurality of hotel property characteristics.

- TravelWeb.com Web Pages (2000), teaches an online system and method for evaluating travel accommodations.

- TripAdvisor.com Web Pages (2002), teaches an online system and method for evaluating travel accommodations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Van Doren Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3623